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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,985	07/11/2003	Frank C. Dickinson	003534-107	9916

21839 7590 07/26/2004

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EXAMINER

HUNTER, ALVIN A

ART UNIT PAPER NUMBER

3711

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/616,985	<b>Applicant(s)</b> DICKINSON, FRANK C	
	<b>Examiner</b> Alvin A. Hunter	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-18 is/are rejected.
- 7) ☒ Claim(s) 10 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/05/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the insert" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Straza et al. (USPN 4681322).

Regarding claim 1, Straza et al. discloses a golf club head 10 comprising a striking face 14 having a recess 34, and a faceplate 26 comprising a front surface 54

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and a back surface and angled spin-control elements 28 between the front and back surfaces (See Figures 1-6).

Regarding claim 2, Straza et al. discloses the spin-control elements parallel to each other (See Figure 3).

Regarding claim 5, Straza et al. discloses the elements are of the same or different material having the same or different hardness relative to each other and/or the remainder of the insert (See Column 3, lines 3 through 38).

Regarding claim 17, Straza et al. discloses a club designed to impart spin to a golf ball comprising a club head with an insert of soft polymeric material having a striking face located in the recess, the insert having a front surface, a back surface and a plurality of angled spaced apart spin control elements therebetween, the spin control elements being arranged in the soft polymeric material such that a golf ball struck by the front surface of the insert is caused to rotate in a clockwise direction as the ball moves away from the front surface (See Figure 1-6 and Column 3, lines 3 through 38). It is submitted that since Straza has the same structure, it is capable of being used as a putter (See MPEP 2112)

3. Claims 1, 2, 3, 5, 6, 7, 8, 9, 11, 12, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Solhelm (GB 2388792 A).

Regarding claim 1, Solhelm discloses a golf club head comprising a striking face having a recess, and a faceplate comprising a front surface and a back surface and angled spin-control elements between said front and back surfaces (See Figures 1-9 and Page 8 through 10).

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Regarding claim 2, Solhelm discloses the spin-control elements are parallel to each other.

Regarding claim 3, Solhelm discloses the spin-control elements are at varied angles to the front surface, the angles increasing or decreasing in a direction away from a central portion of the faceplate, because bubbles inherently have varied angle with respect to the front surface being that they are circular.

Regarding claim 5, Solhelm discloses the elements being of the same or different material having the same or different hardness relative to each other and/or the remainder of the insert.

Regarding claim 6, Solhelm discloses the elements being solid objects which terminate at the front surface (See Page 8 through 10).

Regarding claim 7, Solhelm discloses the elements being voids which open to the back surface or solid objects which terminate at the back surface (See Page 8 through 10).

Regarding claim 8, Solhelm discloses the faceplate comprises a plurality of pixels; wherein the back endwalls of the pixels in contact with a back surface of the recess, the back surface being are at an oblique angle to the front surface being that a bubble is circular and has many oblique angles (See Page 8 through 10).

Regarding claim 9, Solhelm discloses the elements comprise hollow voids disposed at an oblique angle to the front surface being that a bubble is circular and has many oblique angles (See Page 8 through 10).

Regarding claim 11, Solhelm discloses the elements comprise a plurality of voids in communication with the front surface disposed at an oblique angle to the front surface being that a bubble is circular and has many oblique angles (See Page 8 through 10).

Regarding claim 12, Solhelm discloses the elements comprise a plurality of voids in communication with the back surface disposed at an oblique angle to the front surface being that a bubble is circular and has many oblique angles (See Page 8 through 10).

Regarding 17, Solhelm discloses a putter designed to impart spin to a golf ball comprising: a putter head with an insert of soft polymeric material having a striking face located in the recess, the insert having a front surface, a back surface and a plurality of angled spaced apart spin control elements therebetween, the spin control elements being arranged in the soft polymeric material such that a golf ball struck by the front surface of the insert is caused to rotate in a clockwise direction as the ball moves away from the front surface (See Figures 1-9 and Page 8 through 10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 13-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solhelm (GB 2388792 A).

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Regarding claim 4, Solhelm discloses at least one of the elements at the central portion is disposed perpendicular to the front surface being that it is disclosed that the size and distribution of the bubbles may be selected as desired by the inventor (See Paragraph bridging pages 8 and 9). One having ordinary skill in the art would have found it obvious to have the spin elements parallel to each other in order to alter the mechanical characteristics of the club head.

Regarding claims 13 and 14, Solhelm discloses that the spin elements 602 may be of any design and may be pins (See Page 9, 4<sup>th</sup> paragraph and Figure 7). One having ordinary skill in the art would have found it obvious to orient the spin elements at any angle so long as the invention is attained.

Regarding claims 15 and 18, Applicant notes that holes and slots assert no advantage over the other (See Page 8, paragraph 0026). Therefore, one having ordinary skill in the art would have come to the conclusion that having channels is an obvious matter of design choice. The voids of Solhelm would have performed equally as well because it allows the use to change the mechanical characteristic of the golf club.

#### ***Allowable Subject Matter***

Claims 10 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.

  
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